

Response to Office Action Mailed November 15, 2002

A. Claims In the Case:

Claim 278-286 and 288-292 have been rejected. Claims 278-286, 288-292 and 443 are pending. Claims 278, 285, 286, 288, 289 and 292 have been amended. Claim 443 is new.

B. Information Disclosure Statement

Applicant has submitted the documents requested by the Examiner from the Information Disclosure Statement mailed January 15, 2002 and new references in an enclosed Information Disclosure Statement and an electronic Information Disclosure Statement.

C. The Claims Are Not Indefinite Pursuant To 35 U.S.C. § 112, Second Paragraph

Claim 286 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 286 for clarification.

D. The Claims Are Not Anticipated Over Kachel et al. Pursuant To 35 U.S.C. § 102(b)

The Examiner has rejected claims 278-284 and 288-292 as being unpatentable over European Patent No. 03818164 A2 to Kachel et al. (herein "Kachel"). Applicant respectfully disagrees with these rejections.

The standard for "anticipation" is one of fairly strict identity. To anticipate a claim of a patent, a single prior source must contain all the claimed essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q.81, 91 (Fed.Cir. 1986); *In re Donahue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed.Cir. 1985).

Amended claim 278, describes a computer software program for determining a front mold, a back mold and a gasket which together produce a mold cavity, the mold cavity being configured to hold a lens forming composition, wherein the lens forming composition is curable by activating light, that includes a combination of features including, but not limited to, the feature of: “determining curing conditions for a lens based on the eyeglass prescription.”

Support for the amendments to the claim is found in Applicant’s original claim 287 and in Applicant’s specification, which states,

More particularly, the invention relates to a lens forming composition, system and method for making photochromic, ultraviolet/visible light absorbing, and colored plastic lenses by curing the lens forming composition using activating light.
(Specification, page 1, lines 5-8)

Applicant submits that Kachel does not appear to teach or suggest the combination of the features of the claim. Kachel appears to teach an automated apparatus to fill mold forms and then placing the mold forms in an oven for thermal curing. Kachel states,

After all the gasket assemblies have been filled with resin, the operator places them in the oven or ovens 26 as the case may be. The ovens 26 subject the resin to a heat cycle which will cause solidification. The typical cycle time will be overnight, however, shorter cycle times may be utilized depending on the resin formulation.
(Kachel, page 16, lines 45-55).

Applicant respectfully submits that Kachel does not appear to teach or suggest the combination of the features of the claim including, but not limited to, the feature of: “determining curing conditions for a lens based on the eyeglass prescription.” As such, Applicant submits that claim 278 and the claims dependent thereon (claims 279-284 and 288-292) are patentable over Kachel.

E. **The Claims Are Not Obvious Over Kachel Pursuant To 35 U.S.C. § 103(a)**

The Examiner has rejected claims 285-286 as being unpatentable Kachel. Applicant

respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 USPQ 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Amended claim 285 states in part, “wherein the front mold member comprises a front mold identification marking, the back mold member comprises a back mold identification marking, the gasket member comprises a gasket identification marking, and wherein the front mold identification marking comprises an alphanumeric sequence, and wherein the back mold identification marking comprises an alphanumeric sequence, and wherein the gasket identification marking comprises an alphanumeric sequence.”

Amended claim 286 states in part, “wherein the front mold member comprises a front mold identification marking, the back mold member comprises a back mold identification marking, the gasket member comprises a gasket identification marking, and wherein the operations further comprise producing a visual display of the front mold identification marking, the back mold identification marking, and the gasket identification marking subsequent to analyzing the prescription data.”

Applicant submits, for at least the reasons states above, the features of claims 285 and 286 in combination with the features of independent claim 278 are patentable over Kachel.

F. Many Of The Dependent Claims Are Separately Patentable

The Examiner is also respectfully requested to separately consider each of the dependent claims for patentability. Many of the dependent claims in addition to those mentioned above are independently patentable.

Claim 279 states in part, “wherein the prescription information comprises a sphere power, a cylinder power, and a lens location.” Applicant submits that claim 279 in combination with the features of independent claim 278 is patentable over Kachel.

Claim 280 states in part, “wherein the prescription information comprises a sphere power, a cylinder power and a lens location, and wherein the prescription information is analyzed by correlating the sphere power, cylinder power and the lens location to a record in an information database.” Applicant submits that claim 280 in combination with the features of independent claim 278 is patentable over Kachel

Claim 281 states in part, “wherein the prescription information further comprises monomer type and lens type.” Applicant submits that claim 281 in combination with the features of independent claim 278 is patentable over Kachel

Claim 282 states in part, “ wherein the prescription information comprises a sphere power, a cylinder power, an add power and a lens location.” Applicant submits that claim 282 in combination with the features of independent claim 278 is patentable over Kachel

Claim 283 states in part, “wherein the prescription information comprises a sphere power, a cylinder power, an add power, and a lens location and wherein the prescription information is analyzed by correlating the sphere power, the cylinder power, the add power, and the lens location to a record in an information database.” Applicant submits that claim 283 in combination with the features of independent claim 278 is patentable over Kachel.

Claim 284 states in part, “wherein the prescription information further comprises monomer type and lens type.” Applicant submits that claim 284 in combination with the feature of independent claim 278 is patentable over Kachel.

Amended claim 288 states in part, “wherein the operations further comprise controlling a lens curing unit, the lens curing unit being configured to cure the lens forming composition.”

Applicant submits that claim 288 in combination with the features of independent claim 278 is patentable over Kachel.

Amended claim 289 states in part, “wherein the operations further comprise controlling a lens curing unit, the lens curing unit being configured to cure the lens forming composition, wherein controlling the lens curing unit comprises operating the lens curing unit such that the curing conditions are produced.” Applicant submits that claim 289 in combination with the features of independent claim 278 is patentable over Kachel.

Claim 290 states in part, “wherein the operations further comprise allowing the eyeglass prescription to be altered after the eyeglass prescription is collected.” Applicant submits that claim 290 in combination with the features of independent claim 278 is patentable over Kachel.

Claim 291 states in part, “wherein the operations further comprise storing the eyeglass prescription on a computer readable media.” Applicant submits that claim 291 in combination with the features of independent claim 278 is patentable over Kachel.

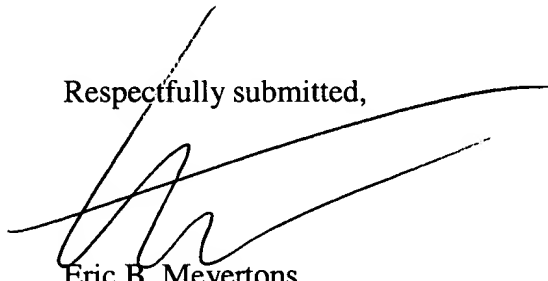
Amended claim 292 states in part, “wherein the operations further comprise controlling a coating unit, the coating unit configured to produce a coating on at least one of the mold members or the eyeglass lens.” Applicant submits that claim 292 in combination with the features of independent claim 278 is patentable over Kachel.

G. Summary

Based on the above, Applicant submits that all claims are in condition for allowance. Applicant respectfully requests favorable reconsideration.

Applicant respectfully requests a two-month extension of time. If any further extension of time is required, Applicant hereby requests the appropriate extension of time. Applicant has enclosed a Fee Authorization for the extension of time fee. If any additional fees are required or if any fees have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Account Number 50-1505/5040-04207/EBM

Respectfully submitted,



Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicants

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398
(512) 853-8888 (voice)
(512) 853-8801 (facsimile)
Date: 4-14-03